

The corrections needed to pages 12 and 14 are brought to applicants' attention by the Examiner and applicants thank the Examiner for noting them.

In an earnest attempt to advance the prosecution of this application to a satisfactory conclusion applicants have amended claims 1 and 2 to limit the zinc dialkyldithiophosphate to be consistent with the Summary of Invention. As amended the claims also are clearly within the scope of the Examples.

The Examiner rejected claims 1 to 5 under 35 USC 103 based on Igarshi combined with seven references. Nonetheless the combination of eight references fails to suggest applicants' invention.

Applicants have disclosed that a unique and specific combination of ingredients are required to obtain a lube that is capable of retaining friction reduction properties. For example, a particular alkyl group must be present on the ZDDP component. Thus, the ZDDP must be one having all primary alkyl groups or must be a mixture of one having all primary alkyl groups and one having all secondary alkyl groups. Where is that suggested in the cited art? Nowhere! Moreover, the ZDDP is combined with other specified ingredients in specified amounts.

LeSuer, which the Examiner specifically mentions, only discloses mixing mineral oil, zinc dioctylphosphorothioate, an alkylene amine and a polyisobutylene succinic anhydride and boric acid. No mention is made of amounts. No reference is made to salicylates. No indication is given to the effect of alkyl type on ZDDP in combination with the materials of applicants' composition. In summary, no suggestion is made of applicants' invention.

Rowman deals with antiwear, not friction retention, properties and makes no mention of combining with the molydithiocarbonate, the many other ingredients of applicants' composition let alone the specific amounts of those.

White discloses a composition which necessarily contains ZDTP, albeit in reduced amounts along with a synergistic amount of a sulfurized polyolefin. Applicants exclude such a polyolefin additive.

Similar comments can be made with respect to each of the remaining references.

In contrast, the Examples in the instant application speak clearly of the patentability of the claimed invention. Indeed, the claims reflect those Examples and are patentable over the cited art.

Regarding the Examiner's rejection of claims 1 to 5 under 35 USC 112, applicants believe the foregoing amendments obviate that rejection.

Finally pursuant to the provisions of 37 CFR 1.97 (c) and 37 CFR 1.98 applicants respectfully requests the Examiner to consider the following references: Inoue, US 4,529,526 (7/16/85); Arai, US 5,672,572 (9/30/97); Inoue, US 5,744,430 (4/28/98); EP 0699739 A2 (3/6/96) and EP 0304011 (filed 8/16/88).

A copy of each of the foregoing references is enclosed.

The Examiner should note that the Amendment Transmittal Form authorizes the Commission to debit Deposit Account 05-1330 for the required fee under 37 CFR 1.17 (P).

U.S. Patent 4,529,526 discloses a lube composition that includes a sulfoxy molybdenum dithiocarbamate and ZDDP. No specificity is attached to the alkyl groups on the ZDDP. Indeed they may be the same or different, primary and secondary alkyl and aryl.. Moreover, the composition of the reference includes additional ingredients, e.g., a sulfurized oxymetal organophosphorodithioate, excluded by applicants' claimed composition.

U.S. 5,744,430 discloses a composition which includes a ZDDP component that has the same or different primary, secondary or tertiary alkyl groups.

The composition includes a metal salicylate in which the metal may be magnesium, calcium or a mixture of both. The composition of the reference, however, also requires the presence of other specified ingredients such as phenol antioxidants.

U.S. 5,672,572 discloses a Composition containing a ZDDP component, a MODTC component and a calcium salicylate component. The ZDDP component may be one having all secondary alkyl groups or a mixture of one having secondary alkyl groups with one

having primary alkyl groups. Importantly the reference states that calcium sulfonate and calcium salicylate must be present in the composition. This combination is excluded from applicants' composition.

EPO 699739 A2 discloses a composition that includes MoDTC and ZDTP. The organo substituents on the ZDTP may be primary and secondary alkyl or aryl. Additionally the composition includes an organic polysulfide not present in applicants' composition.

ER 0304011 discloses a composition that contains a ZDDP in which the alkyl groups are primary alkyl groups. The composition of the reference also includes a moly compound but not a MODTC. Moreover, the composition of the reference fails to disclose the unique combustion of ingredients set forth in the applicants' claims.

In view of the foregoing applicants respectfully request the Examiner to reconsider and withdraw her rejection and pass the case to issue.

Respectfully submitted,



Joseph J. Allocca
Attorney for Applicant(s)
Registration No. 27766
Telephone No. (201) 765-1446
913

Exxon Research and Engineering Company
P. O. Box 390
Florham Park, New Jersey 07932-0390
02099901JJD:cdf